

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application of:	)	
	)	
KRULL, JAY DEE	)	Attorney Docket No.:
	)	702.152
Serial No.: 10/032,032	)	(1528.024US1)
	)	
Filed: December 21, 2001	)	Group Art Unit No. 3661
	)	
PDA WITH INTEGRATED ADDRESS BOOK	)	
AND ELECTRONIC MAP WAYPOINTS	)	Examiner: CAMBY, R. M.

**REPLY BRIEF**

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Alexandria, VA 22313-1450

**APPELLANT'S REPLY BRIEF ON APPEAL**

In response to the Examiner's answer, Appellant's reply brief on Appeal in accordance with 37 C.F.R. § 41.41 is hereby submitted. The Examiner's rejections of claims 1-22 and 28-38 remain appealed, and allowance of said claims is respectfully requested.

Any additional fee which is due in connection with this brief should be applied against our Deposit Account No. 501-791.

Respectfully submitted,

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The requisite statements under 37 C.F.R. § 41.37 were made in the Appeal Brief and acknowledged in the Examiner's Answer.

Claims 1-22 and 28-38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yokoyama, U.S. Patent No. 5,654,908. Applicant appeals from this ground for rejection.

### **Summary of Arguments**

Appellant respectfully submits that the Examiner has failed to cite prior art references that either teach each claim limitation or provide the requisite motivation or suggestion for modifying Yokoyama to include the limitations. In fact, Yokoyama teaches away from the claimed invention, and therefore there can be no suggestion to make the Examiner's proposed modification.

### **Summary of Yokoyama**

Yokoyama teaches that "the navigation apparatus 50 is mounted in a motor vehicle". Column 3. "Having received the destination data, the navigation apparatus 50 establishes the intended route to the destination, ready for guiding the user M along the route when user M gets into the motor vehicle". *Id.* "FIG. 2 shows the relationship between the electronic diary 10 and navigation apparatus 50". *Id.* Thus, Yokoyama explicitly teaches that his diary 10 is operated independently of and remote from his navigation apparatus 50 which is fixedly mounted in the vehicle ready and waiting there for the user. This

configuration allows the user to remotely send the destination data to the navigation apparatus 50 and let it calculate the route, while the diary 10 is free to handle other tasks. Thus, Yokoyama explicitly teaches a diary 10 that is completely separate from his navigation apparatus 50 which is purposefully permanently mounted in the motor vehicle.

This distribution of functionality is not required by space limitations. Rather, as discussed above, Yokoyama teaches specific utility in his diary 10 being portable and traveling with the user. Yokoyama further teaches specific utility in his navigation apparatus 50 operating within his vehicle, separately and independently from his diary 10. Yokoyama is devoid of any suggestion of space limitations. Thus, Yokoyama's distribution of functionality is not required by space limitations and space limitations would not motivate the Examiner's proposed modification of Yokoyama.

**The Examiner failed to establish a *prima facie* case of obviousness as Yokoyama does not teach each currently pending claim limitation.**

The Examiner acknowledges that "Yokoyama lacks that the GPS capabilities are within the PDA device". Final Office Action, dated February 3, 2006, Page 3.

- **Claim 1**

Claim 1 recites "wherein the location is identified and the PDA address book entry is associated therewith within one portable hand-held device". In contrast, Yokoyama simply does not teach the limitations of claim 1. Rather, as shown in his Figure 2, Yokoyama

teaches two separate devices. His diary 10 is used to identify a destination, by address, and that address is sent to his navigation apparatus 50, mounted in the vehicle. See Figure 2 and column 3, lines 42-46. His navigation apparatus 50 then associates the address with a location. See Figure 8, step s28, and column 6, lines 15-22, and column 7, lines 34-63. Thus, Yokoyama teaches one device to identify an address and a completely separate device, which is not hand-held, to associate the address with a location.

- **Claim 7**

Similarly, Claim 7 recites “wherein the location is associated with the PDA address book entry within one portable hand-held device”. In contrast, Yokoyama simply does not teach the limitations of claim 7. Rather, as discussed, Yokoyama teaches two separate devices, one device to identify an address and a completely separate device, which is not hand-held, to associate a location with an address.

- **Claim 14**

Claim 14 recites “[a] computer-readable medium having computer-executable instructions adapted to associate a Personal Digital Assistant (PDA) address book entry with a location on ***an electronic map that is capable of being displayed on the PDA***”, emphasis added. In contrast, Yokoyama’s electronic diary 10 simply cannot display any map. Rather, Yokoyama requires his navigation apparatus 50 to display any maps. See Column 8. However, the navigation apparatus 50 does not provide any PDA functionality,

and therefore cannot be analogous to a PDA. Thus, Yokoyama fails to teach any map being displayed on a PDA.

- **Claims 15-17**

Claim 15 recites “wherein the computer-executable instructions are further adapted to identify the location based on a GPS-determined current location and then to create the PDA address book entry to be associated with the identified location to form a waypoint”. Claim 16 recites “wherein the computer-executable instructions are further adapted to identify the location based on a cursor position on the electronic map and then to create the PDA address book entry to be associated with the identified location to form a waypoint”. Claim 17 recites “wherein the location is associated with electronic map feature data, and wherein the computer-executable instructions are further adapted to pre-fill the PDA address book entry using the electronic map feature data associated with the location”. These claims each recite some form of creating a PDA address book entry using electronic map data.

In contrast, Yokoyama simply doesn’t work that way. As discussed above, information from Yokoyama’s electronic diary 10 is pushed to his navigation apparatus 50, not the other way around. Yokoyama’s navigation apparatus 50 does not provide the electronic diary 10 with any electronic map data that could be used in creating a PDA address book entry. In fact, the Examiner never even asserts Yokoyama teaches or

suggests these limitations. Specifically, the Examiner fails to address the limitations of the dependent claims.

- **Claims 19-21**

Claim 19 recites “wherein the computer-executable instructions are further adapted to create the PDA address book entry, and then associate a location with the PDA address book entry to form a waypoint”. Claim 20 recites “wherein the computer-executable instructions are further adapted to display the waypoint on the electronic map”. Claim 21 recites “wherein the computer-executable instructions are further adapted to provide route guidance to the waypoint”. Thus, these claims explicitly require the same set of computer instructions that associates “a Personal Digital Assistant (PDA) address book entry with a location on an electronic map that is capable of being displayed on the PDA”, as claimed in claim 14, to also form, display, and/or route to the waypoint. As discussed above, Yokoyama requires multiple components to provide this functionality. In fact, the Examiner never even asserts Yokoyama teaches or suggests these limitations. Specifically, the Examiner fails to address the limitations of the dependent claims.

- **Claim 28**

Claim 28 recites “[a] Personal Digital Assistant (PDA) device with an integrated electronic map and address book” and “***wherein the device is adapted to associate a***

***location that is capable of being displayed on the electronic map with a PDA address book entry to form a waypoint***', emphasis added.

In contrast, as discussed above, Yokoyama requires his navigation apparatus 50 to provide mapping capabilities, which his electronic diary 10 cannot provide. Simply put, as previously argued, Yokoyama fails to disclose integration of the claimed functionality, such as associating locations with address book entries, into one PDA device.

- **Claims 30, 32, 33, 35, 36, and 37**

Claim 30 recites "wherein the device is adapted to pre-fill data fields in the PDA address book entry with electronic map data associated with the location". Claim 32 recites "wherein the device is adapted to create the PDA address book entry, and then identify the location associated with the PDA address book entry". Claim 33 recites "wherein the device is adapted to route to the waypoint on the electronic map". Claim 35 recites "a Global Positioning System (GPS) receiver integral to the PDA". Claim 36 recites "wherein the location associated with the PDA address book entry is determined by a GPS-determined location of the GPS receiver". Claim 37 recites "wherein the location associated with the PDA address book entry is determined by a cursor position on the electronic map".

In contrast, as discussed above, Yokoyama requires his navigation apparatus 50 to provide mapping capabilities, which his electronic diary 10 cannot provide. Simply put, as previously argued, Yokoyama fails to disclose integration of the claimed functionality, such



as GPS capabilities, routing capabilities, map data manipulation, and associating locations with address book entries, into one PDA device. In fact, the Examiner never even asserts Yokoyama teaches or suggests these limitations. Specifically, the Examiner fails to address the limitations of the dependent claims.

**The Examiner failed to establish a *prima facie* case of obviousness as the prior art does not provide the requisite motivation or suggestion for modifying Yokoyama to include the currently pending claim limitations and in fact teaches away from any modification to include the currently pending claim limitations.**

The Examiner argues that “[t]his combination of devices is considered obvious in light of the ability of technology to shrink electronics and provide more in a small space and cut down on communication costs”. Final Office Action, dated February 3, 2006, Page 3. The Examiner also argues “that since old technology requires 2 devices because of space limitations that this does not teach away from advancement”. *Id.*

However, the Examiner does not cite any references that actually teach that “[t]his combination of devices is considered obvious”. Furthermore, such assertions ignore the explicit teachings of Yokoyama. Specifically, as discussed above, Yokoyama teaches that “the diary 10 can be held in the hand” and “the navigation apparatus 50 is mounted in a motor vehicle”. Column 3. “The electronic diary 10 transmits the data which specifies a selected destination ... to navigation apparatus 50 via radio waves or the like, when a user M selects the desired destination [on the diary 10]. Having received the destination data,

the navigation apparatus 50 establishes the intended route to the destination, ready for guiding the user M along the route when user M gets into the motor vehicle”. *Id.* This configuration allows the user to remotely send the destination data to the navigation apparatus 50 and let it calculate the route, while the diary 10 is free to handle other tasks. In other words, Yokoyama’s diary 10 is never tied up calculating the route, and is therefore free to provide separate functionality. Thus, Yokoyama explicitly teaches that his diary 10 is independent of and remote from his navigation apparatus 50 which is mounted in the vehicle ready and waiting there for the user.

This distribution of functionality is not required by space limitations, as suggested by the Examiner. Rather, as discussed above, Yokoyama teaches specific utility in his diary 10 being portable and traveling with the user. Yokoyama also teaches specific utility in his navigation apparatus 50 operating within his vehicle, separately and independently from his diary 10. In fact, combining the two into one device, as the Examiner suggests, would necessarily impede the independent functionality of Yokoyama’s diary 10. Furthermore, Yokoyama is devoid of any suggestion of space limitations. Therefore, rather than succumbing to space limitations, Yokoyama explicitly teaches that his diary 10 is carried around by the user and his navigation apparatus 50 is to be mounted in the vehicle ready and waiting there for the user. Thus, “the ability of technology to shrink electronics and provide more in a small space and cut down on communication costs” would not motivate any modification of Yokoyama. As a result, since Yokoyama teaches specific utility for his

configuration and the Examiner's modification could not provide that utility, Yokoyama teaches away from the Examiner's modifications.

Rather, the Examiner's assertion would only support making Yokoyama's diary 10 and navigation apparatus 50 smaller and cheaper. Such an ability of technology does not suggest combining devices previously explicitly taught to be distinctly separate with each piece having separate utility, not to mention specific utility in their being separate. Such an inference, if permissible, would completely eliminate the burden the courts have placed on the Examiner, in interpreting 35 U.S.C. § 103(a). Thus, neither Yokoyama nor the Examiner's reference to an "ability of technology" provides the requisite motivation for modifying Yokoyama to include the functionality claimed in claims 1-22 and 28-38 into one device.

Finally, in the Examiner's Answer, the Examiner analogizes that "the television and VCD or DVD at first were 2 separate devices and were then combined when the electronics could be made small enough to combine the 2 devices". Examiner's Answer, dated December 12, 2006, Page 4. Applicant believes there are several problems with the Examiner's analogy. First, one need only walk through the aisles of an electronics store to quickly realize that any combined TV/VCR is actually larger than the same picture size TV-only model from the same manufacturer. Thus, space savings is not a motivator for such a combination. Second, rather than to save space, TV/VCR combinations are designed to share resources thereby reaping the associated cost savings. Third, such resource sharing comes at a price. A price Yokoyama explicitly seeks to avoid. For example, Appellant is

unaware of a single TV/VCR combination that lets you watch TV on one channel while recording another channel. This is because TV/VCR combinations typically share just one tuner. As discussed above, this type of resource sharing is exactly what Yokoyama teaches away from. As a result, Yokoyama fails to disclose, suggest, or make obvious the limitations of the currently pending claims.

### **Conclusion**

The Examiner failed, with regard to the rejection of the pending claims under 35 U.S.C. §103(a), to establish the requisite *prima facie* case of obviousness because the cited references do not teach each claim limitation or provide the requisite motivation or suggestion for modifying Yokoyama to include the limitations. In fact, Yokoyama teaches away from the Examiner's proposed modification, and therefore there can be no suggestion to make the Examiner's proposed modification. Finally, as discussed above, the Examiner fails to even assert that Yokoyama teaches the limitations of the dependent claims. As the Examiner failed to establish the requisite *prima facie* case of obviousness, the rejections under 35 U.S.C. § 103(a) cannot be sustained and must be overturned.

Appeal of U.S. Application No. 10/032,032

Accordingly, reversal of the Examiner's rejections is proper, and such favorable action is solicited.

Respectfully submitted,

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